

Amendment mailed July 12, 2006  
In response to the Office Action dated April 18, 2006

### REMARKS

This Amendment is made in response to the Office Action dated April 18, 2006. Claims 1-5 and 32-43 are pending. By this Amendment, claims 34 and 35 has been canceled without prejudice. Applicants have carefully reviewed the arguments presented in the Office Action and respectfully request reconsideration of the claims in view of the remarks presented below.

The Examiner has rejected claims 32, 33 and 36-43 under the judicially created doctrine of obviousness-type double rejection as being unpatentable over claims 1-8 of U. S. Patent No. 6,702,834. Applicants hereby submit a Terminal Disclaimer to overcome this rejection.

Claims 1-4 were rejected under 35 U.S.C. 102 (e) as being anticipated by U.S. Patent No. 6,461,370 to Grey et al. (the "Grey patent"). Applicants, however, strongly disagree with the Examiner's interpretation of the Grey patent. The embodiment which the Examiner relies on in rejecting claims 1-4 completely lacks a structure in which an outer tubular member is coaxially disposed over an inner tubular member having a shorter length than outer member. The Grey patent shows a filtering assembly including an expandable strut assembly made from an outer braid 56 coaxially disposed over an inner braid inner 54. These inner and outer braids 54, 56 collapse and expand a filter mesh 58 (the filter) and act as the mechanism for deploying and collapsing the filter. These inner and outer braids 54, 56 thus function as an expandable strut assembly. These

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inner and outer braids 54, 56, however, are not mounted to an outer tubular member which coaxially disposed over an inner tubular member having a shorter length than the outer tubular member. Rather, each of the inner and outer braids 54, 56 have an end attached to a shaft 38 which is coaxially disposed over a guide wire 30. The Grey patent simply fails to disclose any structure comparable to an outer tubular member coaxially disposed over an inner tubular member onto which these inner and outer braids 54, 56 are mounted. Moreover, there is a complete lack of an inner member having a length shorter than the outer tubular member and having an end adapted to abut against a stop fitting on the shaft member limit the axial movement of the filtering device along the shaft member, as is recited in the pending claims. For at least these reasons alone, the Grey patent fails to disclose the basic elements recited in claims 1-4. Accordingly, Applicants respectfully request the Examiner to withdraw the Grey patent as an anticipatory reference.

Claims 32, 33, 36-39 and 41-43 were rejected under 35 U.S.C. 102 (e) as being anticipated by U.S. Patent No. 6,511,496 to Huter et al. (the "Huter patent"). Applicants note that claims 32 and 38 recite that the layer of polymeric material or coating is selectively deposited only on portions of the strut assembly proximal to the filter. The Huter patent does not disclose the use of selectively depositing of coatings or layers of polymeric materials only on strut regions proximal to the filter. It is noted that the Huter patent uses the layer of polymeric coating deposited on the strut assembly primarily as a

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means for attaching the filter to the struts (See Col. 4, lines 15-37, Col. 7, lines 3-67). In this regard, the layer of polymeric material would have to be placed distal, not proximal, to the opening of the filter to provide the medium to affix the filter to the strut assembly. In manufacturing the filtering device disclosed in the Huter patent, if polymeric material is applied only to the portion of the struts proximal to the filter, then there would be no resulting layer of polymeric material to which the filter would adhere. Therefore, the selective application of polymeric materials or coating to only the proximal portion of the strut assembly is not disclosed in the Huter patent. Accordingly, Applicants request the Examiner to withdraw the Huter patent as an anticipatory reference to claims 32, 33, 38, 39, 41 and 43.

Claim 36 requires that the strut assembly have both regions which experience high strains and low strains during movement between the unexpanded and expanded positions. Claims 36 also recites that the layer of polymeric material is selectively deposited only on regions of the strut assembly which experience low strain. It is in the region of these proximal struts that one or more pieces of embolic debris can collect, rather than being driven into the filter. Applicant's presently claimed invention eliminates this possibility by coating the proximal struts with a polymer which reduces the coefficient of friction to help prevent, or at least make it more difficult for, embolic debris to stick onto a strut. The intent in selectively depositing a slippery polymer coating to these struts is to prevent the coating from extending to areas of the strut assembly

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which experience high strain during device expansion. As the Examiner has acknowledges, this may include the deployment member which helps to deploy the strut assembly during usage. The high strain area of this deployment member may cause certain coating material to crack if the coating is not sufficiently elastic to "stretch" as the strut assembly expands.

Applicants submit that the currently claimed invention of claims 36 and 37 is not disclosed in the Huter patent. The Huter patent shows the use of a polymeric layer disposed along the entire length of the strut assembly. The Huter patent does not discuss whether the strut assembly includes both regions of high strain or low strain. However, assuming that the strut assembly of the Huter patent does include both high strain and low strain regions, then both high strain and low strain regions are shown covered by the polymer in the Huter patent. Therefore, the Huter patent does not show the use of layer polymeric material only on low strain regions. If the Examiner takes the position that the Huter patent teaches only coating struts, which the Examiner states is low strain region, then the device disclosed in the Huter patent fails to disclose the basic structure recited in claim 36 which requires the strut assembly to have both regions of low strain and high strain. Accordingly, Applicants request the Examiner to withdraw the Huter patent as an anticipatory reference to claims 36, 37 and 42.

Claim 5 was rejected under 35 U.S.C. 103 (a) as being unpatentable over the Grey patent. As stated above, the Grey patent lacks the basic elements recited in claims 1-4.

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Therefore, Applicants submit that the claimed invention of claim 5 would not be obvious over the Grey patent. Applicants respectfully request the Examiner to withdraw the obviousness rejection applied to claim 5.

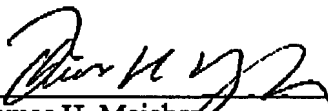
Claim 40 was rejected under 35 U.S.C. 103 (a) as being unpatentable over the Huter patent in view of U. S. Patent No. 5,800,525 to Bachinski et al. (the "Bashinski patent"). As stated above, the Huter patent lacks the elements recited in claim 38. The Bashinski patent fails to disclose this structure or supplies the missing structure from the Huter patent. Therefore, Applicants submit that the combination of the Huter patent with the Bashinski patent fails to create the structure recited in claim 40. Applicants respectfully request the Examiner to withdraw the obviousness rejection applied to claim 40.

In view of the foregoing, it is respectfully urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at (310) 824-5555 to facilitate prosecution of this application, if necessary.

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In light of the above amendments and remarks, Applicants respectfully request  
that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
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**APR 12 2007**

**Client ID/Matter No.: ACSES-65471 (2133XXD)**

**Date Mailed: July 12, 2006**

**Date Due: July 18, 2006**

**Applicant: John F. Boylan et al.**

**Serial No.: 10/664,490**

**Filing Date.: September 17, 2003**

**Title: EMBOLIC PROTECTION DEVICES**

**Documents enclosed:**

- 1. Transmittal (PTO/SB/21)**
- 2. Amendment**

The U.S. Patent and Trademark Office Mail Room stamp hereon acknowledges receipt of the items indicated above on the date shown.

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